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**AUG 13 2004**

**OFFICE OF PETITIONS**

|                               |   |             |
|-------------------------------|---|-------------|
| In re Application of          | : |             |
| Ostrovsky et al.              | : |             |
| Application No. 10/017,534    | : | ON PETITION |
| Filed: October 18, 2001       | : |             |
| Attorney Docket No. 701470.19 | : |             |

This is a decision on the petition under 37 CFR 1.137(a), filed June 18, 2004, to revive the above-identified application on the basis of unavoidable delay.

The petition under 37 CFR 1.137(a) is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled, "Renewed Petition under 37 CFR 1.137(a)." In the alternative, applicant may wish to file petition under 37 CFR 1.137(b), to revive the application on the basis of unintentional delay.

The above-identified application became abandoned for failure to reply within the meaning of 37 CFR 1.113 to the final Office action mailed November 24, 2003, which set a three (3) month shortened statutory period for reply. By advisory action mailed June 2, 2004, applicant was advised that the amendment submitted in response to the final Office Action had been considered, but the proposed amendment was not entered because it did not place the application in better form for appeal by materially reducing or simplifying the issues for appeal.

Consideration of petition under 1.137(a) (Unavoidable Delay):

A grantable petition under 37 CFR 1.137(a) must be accompanied by: (1) the required reply, unless previously filed; (2) the petition fee as set forth in 37 CFR 1.17(1); (3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(c).

The instant petition does not satisfy requirement (3).

As to requirement (3), decisions on reviving abandoned applications on the basis of "unavoidable" delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable: "The word 'unavoidable' ... is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business."<sup>1</sup>

Moreover, delay resulting from the lack of knowledge or improper application of the patent statutes, rules of practice or the MPEP, however, does not constitute "unavoidable" delay.<sup>2</sup>

37 CFR 1.135(b), the regulation relevant to the abandonment of this application, provides that (A) the admission of, or refusal to admit, any amendment after final rejection, or any related proceedings, will not operate to save the application from abandonment; and (B) the admission of, or refusal to admit, any amendment not responsive to the last action, or any related proceedings, will not operate to save the application from abandonment. It is the applicant's responsibility to take the necessary action in an application under a final Office action to provide a complete reply under 37 CFR 1.113. "A delay is not

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<sup>1</sup> In re Mattulath, 38 App. D.C. 497, 514-15 (1912) (quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 U.S.P.Q. 666, 167-68 (D.D.C. 1963), aff'd, 143 U.S.P.Q. 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913).

<sup>2</sup> See Haines, 673 F. Supp. at 317, 5 U.S.P.Q. 2d at 1132; Vincent v. Mossinghoff, 230 U.S.P.Q. 621, 624 (D.D.C. 1985); Smith v. Diamond, 209 U.S.P.Q. 1091 (D.D.C. 1981); Potter v. Dann, 201 U.S.P.Q. 574 (D.D.C. 1978); Ex parte Murray, 1891 Dec. Comm'r Pat. 130, 131 (1891).

'unavoidable' when the applicant simply permits the maximum extendable statutory period for reply to a final Office action to expire while awaiting a notice of allowance or other action."<sup>3</sup>

Applicant may not rely upon late receipt of an advisory action to establish that the delay was unavoidable. 37 CFR 1.116 and 1.135(b) are manifest that proceedings concerning an amendment after final rejection will not operate to avoid abandonment of the application in the absence of a timely and proper appeal.

Applicant should have ensured that the amendment had been entered or should have filed either an Request for Continued Examination (RCE), continuing application, or Notice of Appeal. An applicant should not wait to take action until receipt of an advisory action which might not even be mailed until more than six months after the mailing of the final Office Action.

In the present petition, Joseph K. Liu, attorney of record, stated that his informal discussions with the Examiner led him to believe that the Amendment after final would have been accepted by the Examiner, when in fact the amendment was rejected.

Attorney Liu's attention is directed to 37 CFR 1.2, which reads, in part:

All business with the Patent and Trademark Office should be transacted in writing.... The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. **No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.**

Furthermore, inasmuch as Attorney Liu may have relied upon the oral advice of a USPTO employee rather than ascertaining the applicable regulations and procedures, applicant must bear the risk that such advice is inaccurate.<sup>4</sup>

Conclusion:

While the showing of record is not sufficient to establish to the satisfaction of the Commissioner that the delay was unavoidable,

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<sup>3</sup> MPEP 711.03(c)(III)(C)(2).

<sup>4</sup> See B and B Sales Co. v. Andrew Jergens Co., 7 USPQ2d 1906, 1907 (Comm'r Pat. 1988); In re Sivertz, 227 USPQ 255, 256 (Comm'r Pat. 1985).

applicant is not precluded from obtaining relief by filing a request for reconsideration pursuant to 37 CFR 1.137(b) on the basis of unintentional delay. A grantable petition under 37 CFR 1.137(b) must be accompanied by: (1) the reply required to the outstanding Office action or notice, unless previously filed; (2) the petition fee set forth in 37 CFR 1.17(m); (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(d).

The Office finance records indicate that applicants' Deposit Account, No. 15-0665, was mistakenly charge a \$1,330.00 petition fee. The \$1,330.00 petition fee will be credited to Deposit Account No. 15-0665. The correct petition fee amount of \$110.00 will be charged to Deposit Account No. 15-0665.

Further correspondence with respect to this matter should be addressed as follows and to the Attention of Petitions Attorney Christina Tartera Donnell:

By mail:           Mail Stop Petition  
                  Commissioner for Patents  
                  P.O. Box 1450  
                  Alexandria, VA 22313-1450

By FAX:           (703) 872-9306  
                  Attn: Office of Petitions

By hand:          U.S. Patent and Trademark Office  
                  220 20<sup>th</sup> Street S.  
                  Customer Window, Mail Stop Petition  
                  Crystal Plaza Two, Lobby, Room 1B03  
                  Arlington, VA 22202

Telephone inquiries concerning this decision should be directed to the undersigned at (703) 306-5589.

*Christina Tartera Donnell*

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